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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENDRA L. DUNLAP, DELLAS G. FREDERIKSEN,
and DUSTIN C. ROSING

Appeal 2008-1993
Application 09/967,303¹
Technology Center 2100

Decided: November 18, 2008

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and
JEAN R. HOMERE, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 23. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ Filed on September 27, 2001. The real party in interest is Hewlett Packard Development Co, LP.

Appellants' Invention

Appellants invented a method and apparatus for accessing help instructions through command icons on a graphical user interface (GUI). (Spec. 1.) As depicted in Figures 6 and 7, upon entering a help mode in the GUI, the user may select an option to view the short description and/or the detailed description of a selected icon without invoking the function associated with the icon. (Spec. 2, 4-5.)

Illustrative Claim

Independent claim 1 further illustrates the invention. It reads as follows:

1. A method for accessing instructions on a device having a user interface, the method comprising the steps of:

receiving a user-selection of a first help mode displayed on the user interface, the selected first help mode allowing the user to choose an icon for identification of a function associated with the icon without invoking the function;

upon receiving a user-selection of the icon, displaying a help window including an identification of a function associated with the icon and a link to instructions related to accomplishing the function; and

in response to user-selection of the link, displaying the instructions related to accomplishing the function.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Fang	US 6,628,311 B1	Sep. 30, 2003 (filed Feb. 3, 2000)
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Microsoft Word, *Screen Dumps*, 1-5, (1999).

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

1. Claims 1 through 8, 14, 15, and 21 through 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over MS Word Screen Dumps (“MS Word”, hereinafter.)
2. Claims 9 through 13 and 16 through 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of MS Word and Fang.

Appellants’ Contentions

1. Appellants initially argued that MS Word does not teach a first help mode for allowing a user to identify a function associated with a selected icon without invoking the function. (App. Br. 18-22.) Particularly, Appellants argued that the Examiner failed to provide sufficient evidence to show that the icon’s function is disabled upon selecting the MS Word

“What’s That?” entry to create the pop up window as a result of hovering the cursor over the icon or pressing the mouse button. (*Id.* 21.)

2. Next, Appellants argue that MS Word does not teach a help window including a link to instructions related to accomplishing the functions of a selected icon to thereby display the instructions upon selecting the link. (App. Br. 23-27, Reply Br. 4-7.) Particularly, Appellants argue that while MS Word discloses the ‘Microsoft Word Help’ link in the Help window, the user selection of that link does not display instructions related to accomplishing the icon’s function. Rather, the user must painstakingly navigate through the MS Word Help mode, and take a litany of intermediate steps before being able to locate instructions pertaining to the icon’s function. (*Id.*) Further, Appellants argue that there is insufficient rationale for one of ordinary skill to modify MS Word to reduce the number of steps required to access the instructions pertaining to the icon’s function. According to Appellants, the proposed modification would change the principles of operation of the MS Word Help tool. Additionally, Appellants argue such rationale provided by the Examiner is impermissible hindsight as it is gleaned from Appellants’ own disclosure. (*Id.*)

Examiner’s Findings

1. The Examiner provided supplemental evidence to show that upon hovering the cursor over the icon or pressing the mouse button, a pop-up

window displays a description of the icon's function, while the function of the selected icon is disabled. (Ans. 14-18.)

2. The Examiner submits that MS Word's disclosure of a Help window including, *inter alia*, the "Microsoft Word Help" tool and the "What's This?" tool would have led the ordinarily skilled artisan to a system that reduces the number of steps required to access instructions related to accomplishing the function of a selected icon. Therefore, the Examiner concludes that MS Word renders claim 1 unpatentable. (Ans. 9-11.)

II. ISSUE

The pivotal issue before us is whether Appellants have shown that the Examiner erred in concluding that one of ordinary skill in the art would have found sufficient rationale to modify the MS Word Help window to allow a user to display a link to instructions related to accomplishing the functions of a selected icon to thereby display the instructions upon selecting the link, as recited in independent claim 1.

III. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

MS Word

1. MS Word discloses a method for accessing a help menu in a graphical user interface when Microsoft Word is launched on a computer system. (Fig. 2.)
2. Upon the user entering the help menu, MS Word provides the user the option of selecting the “What’s This?” entry and/or the “Microsoft Word Help” tool. (Fig. 2.)
3. If the user selects the “What’s This” entry, upon hovering the mouse over a selected icon or upon clicking on the selected icon, a pop-up window displays a short description of the icon’s function without invoking the function of the icon. (Figs. 3-4. See also Suppl. Evid. Figs. 3 and 5.)
4. If the user selects the “Microsoft Word Help” entry, MS Word displays a query field to allow the user to enter a keyword pertaining to the function of a selected icon. Upon receiving the user’s query, MS Word displays a preprogrammed list of related links from which the user selects a desired link detailing instructions on how to accomplish the function of the selected icon. (Figs. 5-9. See also Suppl. Evid. Fig. 6.)

Fang

5. As shown in Figure 3a, Fang discloses an auxiliary device such as a printer, facsimile, scanner, or a general computer application having a GUI including hyperlinked help messages (42) in a help dialog (40)

displayed when the help icon (26) is selected. (Col. 3, ll. 37-47, col. 4, ll. 16-21.)

6. Upon selecting a link in the dialog box, a computer program is executed to identify appropriate tabs displaying possible reasons corresponding to display controls are deactivated. (Col. 3, ll. 52-65.)

IV. PRINCIPLES OF LAW OBVIOUSNESS

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level

of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR Int’l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739-40 (2007)). “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *KSR*, 127 S. Ct. at 1742.

The reasoning given as support for the conclusion of obviousness can be based on interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art. *KSR*, 127 S. Ct. at 1740-41. *See also Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006).

V. ANALYSIS

Claims 1 through 8, 14, 15, and 21 through 23

We note at the outset that, in the Reply Brief, Appellants have not reiterated their initial argument that MS Word does not teach a first help mode for allowing a user to identify a function associated with a selected icon without invoking the function. Further, we note that Appellants have also not challenged the Examiner's supplemental corroborating evidence submitted to prove that MS Word does in fact teach the cited limitation. We find nonetheless sufficient evidence on the record before us showing that the function of the selected icon is disabled and a pop up window displays a description of the icon's function upon hovering the mouse over the icon or upon double clicking on the icon. (FF. 3.) We therefore find that MS Word teaches the claimed first help mode for allowing a user to identify a function associated with a selected icon without invoking the function.

Next, as set forth in the Findings of Fact section, MS Word discloses a Help window including tools such as "What's This?" and "Microsoft Word Help." (FF. 1-2.) Upon the user selecting the "What's This?" tool, MS Word displays a pop-up window with a brief description of the function of a selected icon. (FF. 3.) Further, upon the user selecting the "Microsoft Word Help" tool, MS Word prompts the user to take a series of intermediate steps leading to displaying instructions related to accomplishing the functions of the selected icon. (FF. 4.) While MS Word requires the user to go through a number of intermediate steps to obtain the necessary instructions to

accomplish the function of the selected icon, it teaches a link that leads to the instructions. We find nothing in Appellants' claim that precludes the user from going through the intermediate steps before obtaining the instructions. The claim merely calls for the help window to include a link to display instructions related to accomplishing the function of a selected icon. We find that the Microsoft Help tool teaches such a link that also leads to displaying the instructions regardless of the intermediate steps required to get there. Therefore, one of ordinary skilled in the art would readily recognize that MS Word discloses prior art elements that perform their ordinary functions to *predictably* result in a Help window that allows a user to display identification information of the function of a selected icon, as well as a link for obtaining instructions on how to accomplish the icon's function. In fact, we find that MS Word reasonably teaches all the limitations of claim 1. The ordinarily skilled artisan would thus need not modify MS Word's teachings in any way to meet the claimed limitations. For these same reasons, Appellants' arguments that there is insufficient or improper rationale to modify the MS Word teaching is not persuasive.

It follows that Appellants have not shown that the Examiner erred in concluding that the MS Word renders independent claim 1 unpatentable.

Appellants separately argue claims 1 through 8, 14, 15, and 21 through 23. However, Appellants repeat in great substance the same arguments offered for claim 1 above. Therefore, we select independent claim 1 as being representative of the cited claims. Consequently, claims 2

through 8, 14, 15, and 21 through 23 fall together with representative claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

Claims 9 through 13, and 16 through 20

Appellants argue that Fang does not teach an auxiliary device, such as a printer, a fax machine or a copier, that runs hyperlinked help messages. (App. Br. 39-54.) Particularly, Appellants argue that while Fang discloses a GUI for controlling such auxiliary devices, they require another computer to help them run the help system. (*Id.*) Further, Appellants argue that there is insufficient rationale to combine the teachings of MS Word with Fang to yield the claimed invention. (*Id.*) We do not agree. We are satisfied that MS Word teaches that a processor is utilized to run the help system. We are further satisfied that Fang discloses a GUI having a plurality of hyperlinked help messages in any of the aforementioned auxiliary devices to control such device. (FF. 5-6.) One of ordinary skilled in the art would readily recognize that MS Word and Fang disclose prior art elements that perform their ordinary functions to predictably result in a computerized auxiliary device having hyperlinked help messages within a GUI for controlling said device. It follows that Appellants have not shown that the Examiner erred in concluding that the combination of MS Word and Fang renders independent claims 9 through 13 unpatentable.

Appellants separately argue claims 9 through 13, and 16 through 20. However, for claims 16 through 20, Appellants repeat in great substance the

same arguments offered for claims 9 through 13 above. Consequently, we sustain the Examiner's rejection of claims 16 through 20 for the same reasons that we sustained claims 9 through 13. 37 C.F.R. § 41.37(c)(1)(vii).

VI. CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in concluding that:

(1) MS Word renders claims 1 through 8, 14, 15, and 21 through 23 unpatentable under 35 U.S.C. § 103(a).

(2) The combination of MS Word and Fang renders claims 9 through 13, and 16 through 20 unpatentable under 35 U.S.C. § 103 (a).

VII. DECISION

We affirm the Examiner's decision rejecting claims 1 through 23 as being unpatentable under 35 U.S.C. § 103(a) .

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Application 09/967,303

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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